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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,055	06/21/2001	Kazunori Masaki	35.C15476	4347

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EXAMINER

MILIA, MARK R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/885,055

Applicant(s)

MASAKI, KAZUNORI

Examiner

Mark R. Milia

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Fig. 1 reference characters "1000" and "2000". Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities: Page 10, line 24, "B" should read "D" and page 20, line 24, "D" should read "C". Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 15-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 15-21 are directed to a computer program. Such a claim is non-statutory because the terminology "computer program" alone has no set definition. A statutory product with descriptive material must include a positive recitation of the computer readable medium, see MPEP 2106. Examiner suggests amending the claims to read "A computer program embodied in a computer readable medium for performing the steps of..." or "A computer readable medium storing a program for performing the steps of..." or any other similar wording which best clarifies the claim and includes a positive recitation of the computer readable medium. Examiner would also like to point out, by another example, that the language used in claim 22 can be used to amend claims 15-21 and thus the combination should ultimately yield only one claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 7-11, 14-18, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5126858 to Kurogane et al. in view of U.S. Patent No. 5905935 to Wakamatsu et al.

Regarding claims 1, 8, and 15, Kurogane discloses a print controlling apparatus, method, and computer readable storage medium storing a program capable of outputting a print paper comprising producing means for producing print data by adding additional information to information to be printed (see Figs. 6 and 7, column 3 line 66-column 4 line 17, column 5 lines 20-64, and column 6 line 55-column 7 line 40) and control means for controlling a print position of the additional information on a print image corresponding to the print data produced by said producing means (see column 6 line 55-column 7 line 40).

Kurogane does not disclose expressly input means for inputting information representing presence/absence of the fold designation by an operator.

Wakamatsu discloses an input means for inputting information representing presence/absence of the fold designation by an operator (see Fig. 4 and column 6 lines 1-13).

Kurogane & Wakamatsu are combinable because they are from the same field of endeavor, printing image documents consistent with printing properties specified by a user.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the folding device as part of a finishing routine of Wakamatsu with the system of placing additional information, in the form of page numbers and header information, in locations specified by a user of Kurogane.

The suggestion/motivation for doing so would have been to provide multiple finishing options and destinations for image documents even when enlargement/reduction options have been chosen by a user and increase the amount of information that can be provided on a single sheet of paper, even over-sized paper, and output the image documents without a disruption in print properties.

Therefore, it would have been obvious to combine Wakamatsu with Kurogane to obtain the invention as specified in claims 1, 8, and 15.

Regarding claims 2, 9, and 16, Kurogane and Wakamatsu disclose the system discussed in claim 1, 8, and 15, and Wakamatsu further discloses wherein the predetermined form is Z-fold (see Figs. 15B and 16, column 6 lines 23-27, and column 7 line 65-column 8 line 25).

Regarding claims 3, 10, and 17, Kurogane and Wakamatsu disclose the system discussed in claim 1, 8, and 15, and Kurogane further discloses wherein the additional information is either header information or footer information (see Figs. 6 and 8 and column 7 lines 25-40).

Regarding claims 4, 11, and 18, Kurogane and Wakamatsu disclose the system discussed in claim 1, 8, and 15, and Kurogane further discloses wherein the additional information is either date information or page information (see Figs. 6 and 7 and column 6 line 55-column 7 line 24).

Regarding claims 7, 14, and 21, Kurogane and Wakamatsu disclose the system discussed in claim 1, 8, and 15, and Kurogane further discloses position selecting means for selecting the position of the additional information on the print image among a plurality of predetermined positions by the operator, and wherein said control means controls the print position of the additional information on the print image, on the basis of the position selected by said position selecting means (see Figs. 6-8 and column 6 line 55-column 7 line 40).

Kurogane & Wakamatsu are combinable because they are from the same field of endeavor, printing image documents consistent with printing properties specified by a user.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the folding device as part of a finishing routine of Wakamatsu with the system of placing additional information, in the form of page numbers and header information, in locations specified by a user of Kurogane.

The suggestion/motivation for doing so would have been to provide multiple finishing options and destinations for image documents even when enlargement/reduction options have been chosen by a user and increase the amount of information that can be provided on a single sheet of paper, even over-sized paper, and output the image documents without a disruption in print properties.

Therefore, it would have been obvious to combine Wakamatsu with Kurogane to obtain the invention as specified in claims 2-4, 7, 9-11, 14, 16-18, and 21.

Claims 5, 12, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurogane and Wakamatsu as applied to claims 2, 9, and 16 above, and further in view of U.S. Patent No. 6045158 to Bergstresser.

Kurogane and Wakamatsu do not disclose expressly wherein control means controls the print position of the additional information on the print image ***in such a manner that the additional information can visually recognized in a condition that the paper is folded, when the fold designation is present.***

Bergstresser discloses wherein control means controls the print position of the additional information on the print image in such a manner that the additional information can visually recognized in a condition that the paper is folded, when the fold designation is present (see Figs. 3a-c, column 4 lines 20-23 and 36-41, and column 5 lines 21-28).

Kurogane, Wakamatsu, & Bergstresser are combinable because they are from the same field of endeavor, printing documents consistent with printing and finishing properties specified by a user.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the printing of indexing and other information on the margin areas of paper as to be viewable when the paper is folded and unfolded.

The suggestion/motivation for doing so would have been to allow the user to easily view index information to open directly to a specific page to obtain the desired information (see column 5 lines 23-28 of Bergstresser).

Therefore, it would have been obvious to combine Bergstresser with Kurogane and Wakamatsu to obtain the invention as specified in claims 5, 12, and 19.

Claims 6, 13, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurogane and Wakamatsu as applied to claims 5, 12, and 19 above, and further in view of U.S. Patent No. 6045158 to Bergstresser.

Kurogane and Wakamatsu do not disclose expressly wherein control means controls the print position of the additional information on the print image ***in such a manner that the additional information can visually recognized also in a condition that the paper is not folded, when the fold designation is present.***

Bergstresser discloses wherein control means controls the print position of the additional information on the print image ***in such a manner that the additional information can visually recognized also in a condition that the paper is not***

folded, when the fold designation is present (see Fig. 2, figure shows that the additional information, which is located in regions 3a-d, is visible even when the paper is not folded).

Kurogane, Wakamatsu, & Bergstresser are combinable because they are from the same field of endeavor, printing documents consistent with printing and finishing properties specified by a user.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the printing of indexing and other information on the margin areas of paper as to be viewable when the paper is folded and unfolded.

The suggestion/motivation for doing so would have been to allow the user to easily view index information to open directly to a specific page to obtain the desired information (see column 5 lines 23-28 of Bergstresser).

Therefore, it would have been obvious to combine Bergstresser with Kurogane and Wakamatsu to obtain the invention as specified in claims 6, 13, and 20.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. To further show state of the art refer to U.S. Patent numbers 6873426 (Farrell), 5207412 (Coons, Jr. et al.), and 5845942 (Hansen et al.) and U.S. Patent Application Publication numbers 2002/0051205 (Teranishi et al.) and 2001/0039554 (Iwasaki).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached at (571) 272-7402. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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